

Remarks

In the Office Action mailed November 13, 2007, the Examiner indicated that the declaration filed on October 24, 2007 is “ineffective to overcome the Hwang [(U.S. Application Pub. No. 2002/0188875)] reference.” *See* Office Action at page 5. In particular, the Examiner stated that evidence submitted is insufficient to establish “diligence from a date prior to the effective date of the Hwang reference (April 24, 2001) to the US filing data of this application,” which was filed on August 29, 2001. *Id.* at page 6.

The critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). *See* M.P.E.P. § 715.07(a). In the instant case, the critical period beginning just prior to the effective of the Hwang reference and the filing date of the present application relates to attorney diligence.

When drafting a patent application, it is “not necessary that an attorney should drop all other work and concentrate on the particular invention involved; if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient.” *Bey v. Kollonitsch* 231 USPQ 967, 970 (Court of Appeals, Federal Circuit 1986); *Rines v. Morgan*, 250 F.2d 365, 369 (Cust. & Pat.App. 1957); *Gould v. General Photonics Corp.* 534 F.Supp. 399 (D.C.Cal., 1982).

In *Gould*, a patent attorney worked on drafting a patent application for five months, from December 2, 1958 to April 6, 1959. 534 F. Supp. 399, 404. During that time, the patent attorney was involved in an infringement trial. *Id.* When determining whether the patent attorney had been diligent during the five month period, the court relied on the patent attorney’s workload during those months. *Id.* The court reasoned that based on the patent attorney’s workload and

the length of the application, the patent attorney had been diligent in drafting, preparing, and filing the application. *Id.*

By this response, Applicant encloses a Declaration by Mark A. Haynes, who worked on drafting the present application. Specifically, the Declaration demonstrates that on April 16, 2001 Mark Haynes sent a fax to 3Com Corporation confirming that he received the disclosure for the present application. *See* Declaration, Item 1. This date pre-dates the 102(e) date of the Hwang reference (i.e., April 24, 2001). As indicated in the fax, the 3Com Docket Number assigned to this application is 3641.BCG. US.P. *See* Exhibit A. Mr. Haynes had a backlog of cases when he received this disclosure. *See* Declaration at Item 3. His standard practice was to docket cases and work on them in chronological order as they are received. *Id.* at Item 2. In 2001, four attorneys worked full time at Haynes, Beffel & Wolfeld LLP. *Id.* at Item 4. Mr. Haynes was involved with litigation matters relating to International Trade Commission (ITC). *Id.* at Item 5. He was also involved in portfolio license negotiations for a large semiconductor company. *Id.* Further, during that time, he continued to work on his backlog of cases. *Id.*

In order to provide an estimated cost and time for completion, Mr. Haynes spoke with one of the inventors about the technology on the phone when he received this disclosure on or about April 16, 2001. *See* Exhibit B and Declaration at Item 6. Based on his workload and the size of his firm, he estimated, in his fax of April 16, 2001, that it would take him approximately 4 months to draft the application. *See* Exhibit A and Declaration at Item 6. Between April 16, 2001 and August 8, 2001, Mr. Haynes worked on his backlog of patent application preparation and prosecution commitments and other related projects. *See* Declaration at Item 6. He worked reasonably diligently to adhere to the estimated filing date. *Id.*

Exhibits C through H provide redacted copies of billing records indicating when Mr. Haynes worked on this application. *Id.* at Item 7. On Wednesday, August 8, 2001, Mr. Haynes

studied the material (in the invention disclosure) and performed an on-line search. *See* Exhibit C. On Thursday, August 9, 2001, Mr. Haynes drafted claims and outlined the application. *See* Exhibit D. On Friday, August 10, 2001, Mr. Haynes continued drafting the application. *See* Exhibit E. On Saturday, August 11, 2001, Mr. Haynes edited the application. *See* Exhibit F. On Monday, August 13, 2001, Mr. Haynes sent a draft application to the inventors for review. *See* Exhibit G. Mr. Haynes finalized the draft application and sent the inventors a final draft of the application on Thursday, August 23, 2001. *See* Exhibit H. Mr. Haynes then filed the application on Wednesday, August 29, 2001

Applicant respectfully submits that in view of the declaration, all of the pending claims 1-27 are in condition for allowance and such action is respectfully requested. The Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.

Respectfully submitted,

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